

SAIC0041-DIV1
Serial Number: 10/797,036

PATENT

REMARKS

Claims 1-15 are pending in this application. Claims 1, 6 and 12 have been amended as set forth above. The Office has rejected the claims as follows: claims 1-10, 12 and 15 are rejected under 35 USC 102(b) as being anticipated by Ovshinsky et al and claims 11 and 13-14 are rejected under 35 USC 103(a) as being unpatentable in view of Ovshinsky

The undersigned respectfully submits that in view of the amendments and arguments hereby presented, the claims are allowable over the art cited.

Rejection of Claims 1-10, 12 and 15 as Being Anticipated by Ovshinsky et al.

Independent claim 1 has been amended to include the limitation "such that electromagnetic energy flowing in the first and second conductive elements resulting from electromagnetic radiation interacting with the circuit containing the switch is either reflected off of the switch or transmitted through the switch depending on the impedance value." The undersigned has reviewed the Ovshinsky reference and finds no teaching of this limitation in combination with the other limitations of claim 1. Accordingly, the undersigned submits that claim 1 and claims 2-10 and 15 are allowable over the cited art.

Claim 12 has been rewritten in independent form. The undersigned notes the Office's statement, "[r]egarding claim 12, Ovshinsky et al. discloses the first and second conductive elements being formed of aluminum [column 13, lines 8-31]," but fails to see how this statement is relevant to the limitations of claim 12. Claim 12 includes *inter alia*, "wherein said first and second conductive elements are the same material as said switching material and said switch element is shaped to switch its phase state to the

SAIC004:-DIV1
Serial Number: 10/797,036

PATENT

second impedance state in response to an application of energy to said switch while said conducting elements remain in said first impedance state, and remains in the second impedance state without continuing the application of energy." These limitations are simply not taught or suggested by Ovshinsky. Accordingly, the undersigned respectfully submits that claim 12 is allowable over Ovshinsky.

Rejection of Claims 11 and 13-14 as Being Unpatentable Over Ovshinsky et al.

For at least the reasons stated above with respect to independent claims 1 and 12, the undersigned respectfully submits that claims 11 and 13-14 are allowable over Ovshinsky et al. Further, the undersigned has reviewed the case, Boesch, cited by the Office in support of the obviousness rejection. The Office, admitting that the limitations of claims 11 and 13-14 are not taught or suggested by the single reference cited, Ovshinsky et al., seeks to prove a *prima facie* case of obviousness through the citation of case law. The standard for proving a *prima facie* case of obviousness is well-established and is set forth in MPEP Section 2142:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

In Boesch, the court recognized (as did the Board), that the references cited included alloy constituent ranges that overlapped with alloy ranges in the claims of the application

SAIC0041-DIV1

PATENT

Serial Number: 10/797,036

second impedance state in response to an application of energy to said switch while said conducting elements remain in said first impedance state, and remains in the second impedance state without continuing the application of energy." These limitations are simply not taught or suggested by Ovshinsky. Accordingly, the undersigned respectfully submits that claim 12 is allowable over Ovshinsky.

Rejection of Claims 11 and 13-14 as Being Unpatentable Over Ovshinsky et al.

For at least the reasons stated above with respect to independent claims 1 and 12, the undersigned respectfully submits that claims 11 and 13-14 are allowable over Ovshinsky et al. Further, the undersigned has reviewed the case, Boesch, cited by the Office in support of the obviousness rejection. The Office, admitting that the limitations of claims 11 and 13-14 are not taught or suggested by the single reference cited, Ovshinsky et al., seeks to prove a *prima facie* case of obviousness through the citation of case law. The standard for proving a *prima facie* case of obviousness is well-established and is set forth in MPEP Section 2142:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

In Boesch, the court recognized (as did the Board), that the references cited included alloy constituent ranges that overlapped with alloy ranges in the claims of the application

SAIC0042-DIV1
Serial Number: 10/797,036

PATENT

and that other cited art expressly articulated the general requirements, i.e., constituent balances and amounts, for achieving desired alloys and thus a *prima facie* case of unpatentability had been established for the claimed ranges and particular constituent balancing equation.

In this case, there is no suggestion in the cited art of at least the following limitations

- "wherein said first and second conductive elements are the same material as said switching material" (Claim 11)
- "wherein the switch element is narrower than the first and second conductive elements" (Claim 13).

Accordingly, unlike Boesch, where the prior art taught overlapping ranges and general balancing relationships, the limitations cited above are not taught or suggested by Ovshinsky and thus no *prima facie* case of unpatentability can be established. There is no suggestion, generally or otherwise, that the switch material and conductive elements may be formed of the same material or that the switch element is narrower than the conductive elements. The application is the only place where these limitations are disclosed and explained. It is impermissible to use the teachings of the instant application to support a *prima facie* case of unpatentability. The holding in Boesch is of no help to the Office in this case.

The undersigned respectfully submits that at least claims 11 and 13 are independently patentable over the cited art for the reasons stated above, irrespective of the patentability of independent claims 1 and 12.

SAIC 042-DIV1
Serial Number: 10/797,036

PATENT

CONCLUSION

The undersigned submits that the claims as amended are allowable over the cited art. The undersigned representative respectfully requests a notice of allowance to this effect. Should the Examiner feel that a teleconference would expedite the prosecution of this application, please do not hesitate to contact the undersigned at the number provided. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account No. 501458.

Respectfully submitted,

Date: 11/24/04
KILPATRICK STOCKTON LLP
Suite 900
607 14th Street, N.W.
Washington, DC 20005
(Ph) 202-508-5889
(Fax) 202-508-5858

By:

Dawn Marie Bey
Dawn-Marie Bey (Reg. No. 44,442)